

DISCUSSION OF THE CLAIMS

Claims 1-5 and 7-26 are pending in the present application. Claims 4, 5, 8, 9, and 11 are presently withdrawn from active prosecution. Claim 6 is a canceled claim. Claims 14-26 are new claims. Claim 14 is a new independent claim. Support for new Claim 14 is found in the previously presented claims. Claim 14 includes the transitional phrase “consists essentially of” which is supported by the original specification including disclosure that properties such as a balance between impact resistance and rigidity are novel properties of the claimed invention. The exclusion of components which materially effect the basic and novel characteristics of the claimed invention is supported by the explicit requirement that certain components are present in particular weight ratios which represent up to 100% by mass of the total mass of the composition.

No new matter is believed to have been added by this amendment.

REMARKS

The Office rejected the claims as anticipated and/or obvious over Abe (US 5,082,888), Koizumi (US 5,082,889) or Sugita (US 2006/0199891). With regard to the rejection over the Abe reference the Office asserts that the cited reference's silence with respect to particles having a size of greater than 40 μm permits a reasonable presumption that these particles are present in the prior art composition in an amount of less than 10%. Based on this assumption, the Office rejects the claims as anticipated.

Applicants submit the Office's rejection of the claims as anticipated in view of the prior art's silence with respect to at least one of the features of the presently claimed invention is legally not supportable. There is no evidence of record that the Abe particles inherently have the property asserted by the Office. The Office's rejection of the claims as anticipated is simply not supportable and should be withdrawn.

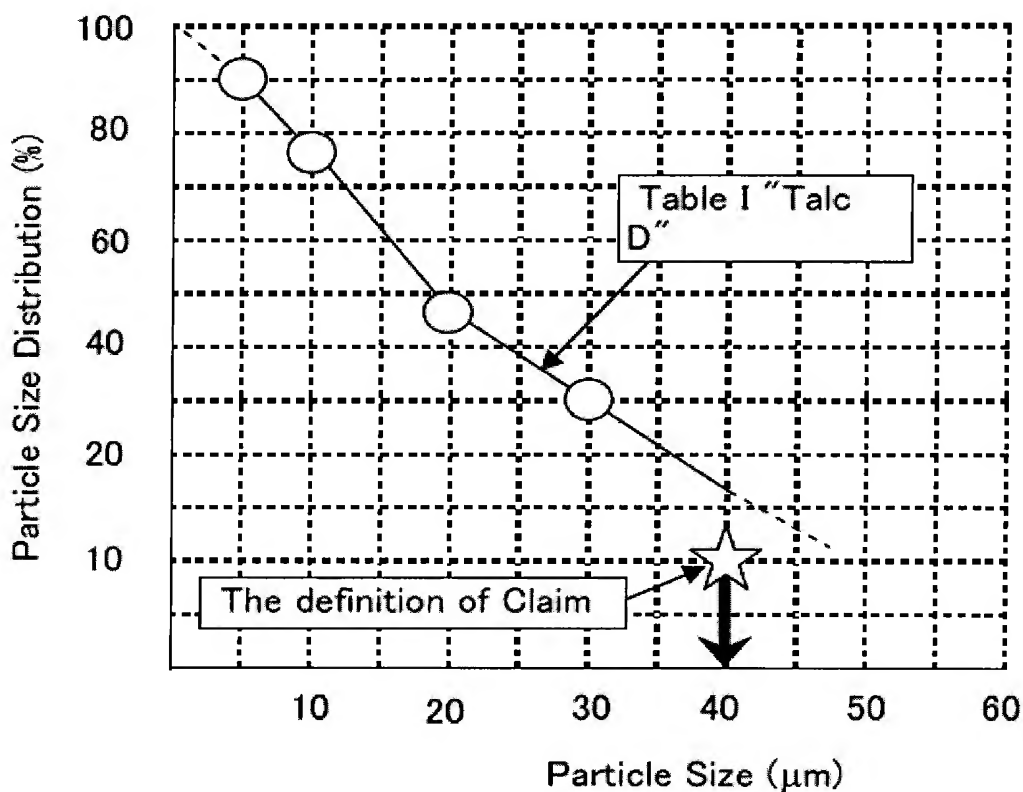
Applicants submit that those of skill in the art would readily recognize that the Abe disclosure is contradictory to the effects and purpose of the presently claimed invention especially with respect to the respective particle size of talc. Abe describes a particle distribution for talc in the following textual manner:

- ≥ 30 μm from about 20% to about 65% by weight;
- ≥ 20 μm from about 40% to about 80% by weight;
- ≥ 10 μm from about 65% to about 95% by weight; and
- ≥ 5 μm not less than about 85% by weight.

See column 2, lines 23-29 of Abe.

The Abe reference is therefore describing a particle size distribution of talc which is biased to larger particle sizes, e.g., to have a large amount of particle size in the range of 15-40 μm .

This stands in stark contrast to the particle size characteristics of the talc recited in the present claims which makes it absolutely clear that the content of particles having a diameter exceeding 40 μm is 10% by mass or smaller. The Abe talc and the talc recited in present Claim 1 can be described, in one respect, as shown in the graph below.



The graph shows the trend of particle size and particle size distribution (percent) in the Abe composition. It is readily evident that the particle size characteristics of the claimed invention are different from and do not lie on the trend line of particle size for the Abe talc.

The talc of the present claims has an important effect on the physical properties of the claimed resin composition. For example, in one embodiment of the invention the resin composition has an izod impact resistance of 15-40 kJ/m^2 (see for example present Claim 3). This may be compared with the izod impact resistance of compositions described in the Abe

patent which have values in the range of 2.1-3.5 kg.cm/cm (corresponding to a value of 2.7-4.5 kJ/m²).¹

It is thus readily evident that the physical properties of the claimed resin composition are substantially different from the physical properties of the resin compositions of Abe.

The Office's rejection of the claims in view of Koizumi is similarly not supportable. Again the cited reference, Koizumi, is silent with respect to the amount of particles having a particle size greater than 40 µm. The Office asserts, without any support whatsoever, that it is reasonable to assume that the Koizumi particles would necessarily (inherently) have an amount of particles of a particle size of 40 µm or greater that is less than 10%.

As was discussed above for Abe, there is simply no factual support for such an assertion and thus the rejection should be withdrawn.

Applicants draw the Office's attention to MPEP § 2112(IV) reproduced below in part:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (Citations omitted). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (Citations omitted).

¹ 1 kJ/m² = 1.2959 kg.cm/cm

$\text{kJ/m}^2 = ((\text{kg.m}^2/\text{s}^2)/\text{m}^2) \times 10^3$

$\text{J} = \text{kg.m}^2/\text{s}^2$ and thus $\text{k} = 10^3$.

Dividing by the acceleration force of gravity, i.e., 9.8 m/s² the following is obtained $\text{kJ/m}^2 = \text{kg.m/m}^2 \times (1/9.8) \times 10^3$ which may be multiplied by the width of the test pieces used to measure izod impact resistance and to convert m to cm provides:

$\text{kJ/m}^2 = \text{kg.cm/cm}^2 \times (1/9.8) \times 10 \times 1.27\text{cm} = 1.2959 \text{ kg.cm/cm}$.

Here the Office makes a wholly unsubstantiated allegation with respect to properties of a prior art composition on which the references are silent.

The Office failed to set forth any reasonable factual basis for this allegation and thus the rejection should be withdrawn.

Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 (the Teramoto Declaration). The Teramoto Declaration provides two additional comparative examples (Comparative Examples 4 and 5 described in the Table on page 2 of the Teramoto Declaration). The comparative examples demonstrate an important effect of including only the talc in the resin composition. Comparative Example 4 includes a small amount of glass fiber in combination with a large amount of talc. Comparative Example 5 includes a small amount of talc and a large amount of mica. The properties for both of the comparative examples are such that they fail the test for air bag expansion.

Applicants submit that the Teramoto Declaration is especially relevant to the subject matter of new dependent Claim 14 which recites the transitional phrase “consisting essentially of.” As described throughout the specification the basic and novel characteristics of the presently claimed resin composition relate to air bag expansion. The Teramoto Declaration makes it clear that compositions which include fillers such as glass fibers and/or mica are excluded from those compositions which consist essentially of the components recited in the new dependent claims. The inclusion of glass or mica necessarily effects the basic and novel materials of the claimed invention because the air bag expansion properties are compromised.

Applicants thus submit that the new dependent claims are further patentable over the cited art.

The present application is a 371 of PCT/JP2004/015226 having a filing date of October 15, 2004. The effective U.S. filing date of the present application is therefore

October 15, 2004. Sugita has an earliest U.S. filing date of March 1, 2006. Applicants submit that Sugita fails to qualify as prior art to the present application and thus the rejection in view of the Sugita publication should be withdrawn.

For the reasons discussed above in detail, Applicants respectfully request withdrawal of the rejection and the allowance of all now-pending claims.

Respectfully submitted,

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